REMARKS

In the Office Action mailed September 3, 2003, Claims 2-6, 8-10 and 21 are rejected under 35 U.S.C. §102(b), as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 2 and further in view of U.S. Pat. No. 6,187,982 issued to Markusch et al. Claims 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 2 and further in view of U.S. Pat. No. 4,853,054 issued to Turner et al. Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 2. Claims 19-28 and 32 are rejected under 35 U.S.C. §102(b), as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. Claims 29 and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 2 and further in view of U.S. Pat. No. 4,853,054 issued to Turner et al. Claim 31 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 1.

Rejections under 35 U.S.C. §§102(b)/103(a)

Claims 2-6, 8-10 and 21 are rejected under 35 U.S.C. §102(b), as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. Applicants respectfully disagree with the Examiner.

Applicants respectfully remind the Examiner that as stated in MPEP §2131, to anticipate a claim, a reference must teach every element of that claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226,1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully contend that the Examiner has

failed to point to where Markusch et al. do so. Applicants respectfully point out to the Examiner that the claims as instantly amended are directed to an isocyanate represented by the formula $Q(NCO)_{n,}$.

Markusch et al. at col. 2, lines 51-57, state,

> The polyisocyanates of this invention have a functionality of less than about 2.4, an isocyanate group content of 25 to 30%, and a urethane group content of from about 2 to 6%, and comprises polymethylene poly(phenylisocyanate), from about 5 to 25% of 4,4'- methylene bis(phenylisocyanate), and from about 20 to 50% of 2,2'- and 2,4'- methylene bis(phenylisocyanate).

Therefore, the teaching of Markusch et al. is directed to a polyisocyanate blend or mixture as stated at col. 2, lines 63-67,

> The functionality of the isocyanate mixture is dictated by the relative amounts of methylene bis(phenylisocyanate) monomers and by the relative amounts and average functionalities of not only polymethylene poly(phenylisocyanate) but also of the urethane-containing species. (Emphasis added)

As stated in MPEP §2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, citing *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Clearly there is no such teaching, suggestion or motivation shown in the reference in this case. Applicants respectfully contend that the teaching of Markusch et al. fails to suggest the instantly claimed isocyanate represented by the formula $Q(NCO)_n$ because Markusch et al. teach an isocyanate blend.

Therefore, applicants contend that nothing in the teaching of Markusch et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claims 2-6, 8-10 and 21 under 35 U.S.C. §102(b), as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al.

Rejections under 35 U.S.C. §§102(b)/103(a)

Claims 19-28 and 32 are rejected under 35 U.S.C. §102(b), as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. Applicants respectfully disagree with the Examiner.

Applicants respectfully remind the Examiner that as stated in MPEP §2131, to anticipate a claim, a reference must teach every element of that claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226,1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully contend that the Examiner has failed to point to where Markusch et al. do so. Applicants again respectfully point out to the Examiner that the claims as instantly amended are directed to an isocyanate represented by the formula $Q(NCO)_{n,}$.

Markusch et al. at col. 2, lines 51-57, state,

> The polyisocyanates of this invention have a functionality of less than about 2.4, an isocyanate group content of 25 to 30%, and a urethane group content of from about 2 to 6%, and comprises polymethylene poly(phenylisocyanate), from about 5 to 25% of 4,4'- methylene bis(phenylisocyanate), and from about 20 to 50% of 2,2'- and 2,4'- methylene bis(phenylisocyanate).

Therefore, the teaching of Markusch et al. is directed to a polyisocyanate blend or mixture as stated at col. 2, lines 63-67,

> The functionality of <u>the isocyanate mixture</u> is dictated by the relative amounts of methylene bis(phenylisocyanate) monomers and by the relative amounts and average functionalities of not only polymethylene poly(phenylisocyanate) but also of the urethane-containing species. (Emphasis added)

As stated in MPEP §2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found

either in the references themselves of in the knowledge generally available to one of ordinary skill in the art, citing *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Clearly there is no such teaching, suggestion or motivation shown in the reference in this case. Applicants respectfully contend that the teaching of Markusch et al. fails to suggest the instantly claimed isocyanate represented by the formula $Q(NCO)_n$ because Markusch et al. teach an isocyanate blend.

Therefore, applicants contend that nothing in the teaching of Markusch et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claims 19-28 and 32 under 35 U.S.C. §102(b), as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al.

Rejections under 35 U.S.C. §103(a)

Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 2 and further in view of U.S. Pat. No. 6,187,982 issued to Markusch et al. Applicants respectfully disagree with the Examiner's contention regarding Markusch et al. '917 in view of Markusch et al. '982.

Applicants' remarks above with respect to Markusch '917 are equally applicable to the instant rejection. Markusch et al. '917 fail to teach or suggest the instantly claimed invention. Further, Markusch et al. '982 appears not to be combinable with Markusch et al. '917 as '917 teaches an isocyanate blend whereas '982 does not. Even if combinable, Markusch et al. '982 fail to add the missing teaching or suggestion to lead one of ordinary skill to the instantly claimed invention.

Therefore, applicants contend that nothing in the teaching of Markusch et al. '917 in view of Markusch et al. '982 would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claim 7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 2 and further in view of U.S. Pat. No. 6,187,982 issued to Markusch et al.

R jections under 35 U.S.C. §103(a)

Claims 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 2 and further in view of U.S. Pat. No. 4,853,054 issued to Turner et al. Applicants respectfully disagree with the Examiner's contention regarding Markusch et al. in view of Turner et al.

Applicants' remarks above with respect to Markusch et al. are equally applicable to the instant rejection. Markusch et al. fail to teach or suggest the instantly claimed invention. Further, Turner et al. fail to add the missing teaching or suggestion to lead one of ordinary skill to the instantly claimed invention.

Therefore, applicants contend that nothing in the combined teachings of Markusch et al. in view of Turner et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claims 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 2 and further in view of U.S. Pat. No. 4,853,054 issued to Turner et al.

Rejections under 35 U.S.C. §103(a)

Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 2. Applicants respectfully disagree with the Examiner's contention regarding Markusch et al.

Applicants' remarks above with respect to Markusch et al. are equally applicable to the instant rejection. Markusch et al. fail to teach or suggest the instantly claimed invention.

Therefore, applicants contend that nothing in the teaching of Markusch et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claim 14 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al.

Rejections under 35 U.S.C. §103(a)

Claims 29 and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to

Claim 2 and further in view of U.S. Pat. No. 4,853,054 issued to Turner et al. Applicants respectfully disagree with the Examiner's contention regarding Markusch et al. in view of Turner et al.

Applicants' remarks above regarding Markusch et al. in view of Turner et al. are equally applicable to the present rejection. Markusch et al. fail to teach or suggest the instantly claimed invention and Turner et al. fail to add the missing teaching or suggestion to lead one of ordinary skill to the instantly claimed invention.

Therefore, applicants contend that nothing in the combined teachings of Markusch et al. in view of Turner et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claims 29 and 30 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 2 and further in view of U.S. Pat. No. 4,853,054 issued to Turner et al.

Rejections under 35 U.S.C. §103(a)

Claim 31 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 1. Applicants believe the Examiner is referring to Claim 2 and not Claim 1 which has been cancelled. Applicants respectfully disagree with the Examiner's contention regarding Markusch et al.

Applicants' remarks above regarding Markusch et al. are equally applicable to the present rejection. Markusch et al. fail to teach or suggest the instantly claimed invention.

Therefore, applicants contend that nothing in the teaching of Markusch et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claim 31 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,558,917 issued to Markusch et al. as applied to Claim 1.

Conclusion

Applicants have amended Claims 2, 19, 21 and 32. Applicants contend that such claim amendments add no new matter and find support in the specification.

Applicants submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 2-14 and 19-32. If the Examiner is of the opinion that the instant application is in condition for other than allowance, she is invited to contact the applicants' Attorney at the telephone number listed below, so that additional changes to the claims may be discussed.

Respectfully submitted,

By _____

John E. Mrozinski, Jr.
Attorney for Applicants
Reg. No. 46,179

Bayer Polymers LLC
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741
PHONE: (412) 777-3024
FACSIMILE PHONE NUMBER:
412-777-3902
s/rmc/jem/0122